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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,026	11/07/2000	John E. Dolan	KLR 7146.098	4960

7590

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EXAMINER

SHERRILL, JASON L

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,026

Applicant(s)

DOLAN ET AL.

Examiner

Jason L Sherrill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 2, 4, 5, 8, 9, 14, 15, 17, 18, 21, 24-30, 34, 35, 40, 41, 43, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Haneda et al. (U.S. Patent No. 6,204,932).

For claims 1 and 25-29, Haneda discloses a method of processing an image comprising: sensing an image from an original document (col. 11, lines 5-17); modifying the image by a first process to compensate for non-uniformities of sensing the image (col. 17, lines 17-44); modifying the image by a second process based upon the image itself (col. 17, lines 58-65); creating a print ready data stream as a result of the modifications of the previous steps (col. 17, line 66 – col. 18, line 14); providing a print ready data stream of the image to a third process;

modifying the image of the print ready data stream by the third process (col. 18, lines 16-24) including mirroring at least a portion of image of the print ready data stream (col. 20, lines 8-14); and providing the modified image as a result of the previous step to an output device (col. 18, lines 31-33).

For claims 2, 15, and 41, Haneda discloses a method of processing an image wherein the sensing is performed by a copy machine (col. 1, lines 11-22).

For claim 4, Haneda discloses a method of processing an image wherein the sensing is performed by a scanner (abs., lines 1-3)

For claims 5 and 30, Haneda discloses a method of processing an image wherein the output device is a printer (col. 18, lines 31-33).

For claims 8, 17, 34, and 43, Haneda discloses a method of processing an image wherein the third process includes mirroring at least a portion of the image of the print ready data stream (col. 18, lines 16-24; col. 20, lines 8-14).

For claims 9, 18, 35, and 44, Haneda discloses a method of processing an image wherein the third process includes mirroring the entire image (col. 20, lines 8-14).

For claims 14 and 40, Haneda discloses a method of processing an image comprising: sensing an image from an original document (col. 11, lines 5-17); modifying the image by a first process to compensate for non-uniformities of sensing the image (col. 17, lines 17-44); modifying the image by a second process based upon the image itself (col. 17, lines 58-65); selecting from among a first mode, a second mode and a third mode; the first mode modifying the image by performing mirroring of at least a portion of the image (col. 18, lines 16-24; col. 20,

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lines 8-14); a second mode comprising storing the image within a buffer (col. 4, lines 57-63); and providing the modified image to an output device (col. 18, lines 31-33).

For claim 21, Haneda discloses a method of processing an image comprising: sensing an image from an original document (col. 11, lines 5-17); modifying the image by a first process to compensate for non-uniformities of sensing the image (col. 17, lines 17-44); modifying the image by a second process based upon the image itself (col. 17, lines 58-65); storing the image in a compressed form in a buffer if the modified image requires sufficiently less memory for storing than the size of the buffer (col. 5, lines 35-52; col. 9, lines 18-37).

For claim 24, Haneda discloses a method of processing an image wherein the compressed image is provided to an output device multiple times free from re-sensing the original document (col. 21, lines 46-51).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda ('932').

For claim 3, Haneda fails to directly teach that a facsimile machine performs the sensing. However, Haneda discloses that the sensing is performed by an image scanner or by

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photoelectric conversion (abs., lines 1-3; col. 1, lines 1-10). Therefore it would obvious to one of ordinary skill in the art at the time the invention was made to consider that a facsimile machine would qualify as an image sensing apparatus as disclosed.

For claim 22, Haneda fails to directly teach that the image is sensed a first time to determine if the modified image requires sufficiently less memory for storing than the size of the buffer, and the image is sensed a second time to store the resulting modified sensed image in the buffer. However, Haneda discloses compression mode selections wherein the priority may be set for a higher image quality or a compression rate (col. 9, lines 12-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to consider that the apparatus of Haneda would consider the size of the image data and apply the proper steps in accordance with the memory/quality priority, which has been set.

6. Claims 6, 7, 10-13, 16, 20, 31, 32, 36-39, 42, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda ('932') as applied to claims 1, 14, 25 and 40 above, and further in view of Rourke (U.S. Patent No. 5,191,429).

For claims 6, 7, 16, 31, 32 and 42, Haneda fails to disclose that the output device is a print ready file transferred across a network.

Rourke discloses that the output device can be a file (col. 4, lines 25-40), which could be transferred over a network (col. 2, lines 46-54). It would obvious to one of ordinary skill in the art at the time the invention was made to combine the ability of Rourke to store the data in a file to the document scanning system of Haneda because both teach image reading apparatuses which perform image processing on a document prior to printing. The improvement on Haneda

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by Rourke would provide more options for use of the image data such as, transferring over a network or printing at a later date.

For claims 10-13, 19, 20, 36-39, 45 and 46, Rourke discloses vertically and horizontally cloning the entire image (col. 1, line 60 – col. 2, line 4; col. 6, lines 22-34; col. 7, lines 55-67).

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haneda ('932') as applied to claim 21 above, and further in view of Miura (U.S. Patent No. 5,533,171).

For claim 23, Haneda fails to disclose that the modified image is simultaneously provided to an output device and stored in a buffer.

Miura discloses that the modified image is simultaneously provided to an output device and stored in a buffer (col. 14, lines 48-52).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Tsuboi et al. (U.S. Patent No. 5,124,799) discloses a digital copying apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L Sherrill whose telephone number is 703-306-4053. The examiner can normally be reached on M-F 7:30-4:00.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone numbers for the


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organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JLS

December 14, 2003


EDWARD COLES
SUPERVISING PATENT EXAMINER
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